

ESTTA Tracking number: **ESTTA422315**

Filing date: **07/28/2011**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92053542
Party	Defendant Fegley Enterprises, Inc.
Correspondence Address	JEANNE HAMBURG NORRIS McLAUGHLIN & MARCUS PA 875 THIRD AVENUE 8TH FLOOR NEW YORK, NY 10022 UNITED STATES jhamburg@nmmlaw.com,bcmarin@nmmlaw.com,blarocca@nmmlaw.com
Submission	Motion to Amend/Amended Answer or Counterclaim
Filer's Name	Jeanne Hamburg
Filer's e-mail	jhamburg@nmmlaw.com,bcmarin@nmmlaw.com,blarocca@nmmlaw.com
Signature	/jeanne hamburg/
Date	07/28/2011
Attachments	motion to amend.pdf ( 14 pages )(3258262 bytes ) certificate of service motion.pdf ( 1 page )(6299 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of U.S. Registration No. 3,047,757  
For the mark **RUDE ELF'S RESERVE & Design**

TROEGS BREWING COMPANY,

Petitioner,

-v.-

FEGLEY ENTERPRISES, INC.

Registrant.

Cancellation Number: 92053542

**MOTION FOR LEAVE TO AMEND ANSWER TO ADD COUNTERCLAIMS AND  
TO SUSPEND PROCEEDING PENDING DETERMINATION OF THIS MOTION**

Registrant Fegley Enterprises, Inc. ("Fegley"), by its counsel, hereby moves to amend its answer to add counterclaims petitioning the Board to cancel Registration No. 2887242 upon which Petitioner Troegs Brewing Company ("Petitioner") in part bases its claims in this proceeding, based on newly discovered evidence produced this month by Petitioner in this proceeding.

Both parties in this action sell beers and ales under their respective marks, including those in issue in this proceeding. In this proceeding, Petitioner seeks to cancel Fegley's Registration No. 3047757 for the mark shown on the following page:



Hereafter this mark is referred to as the “Fegley Mark”.

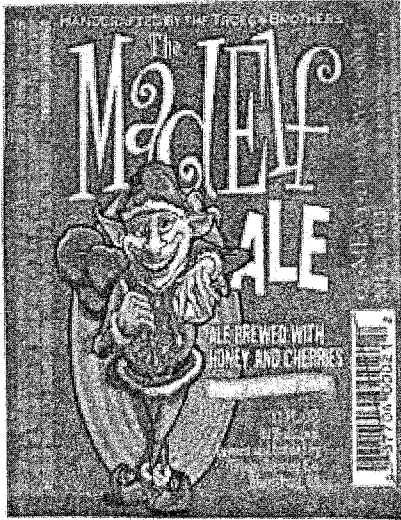
Petitioner’s cancellation petition is based in part on its claim of prior use of the mark shown in Registration No. 2887252, namely:



Hereafter this mark is referred to as the “Old Troegs Mark”.

Documents produced by Petitioner in discovery show that in or about July, 2006, well after Respondent began use and had already registered the Fegley Mark, Petitioner adopted a new mark.

This mark, shown below and hereafter referred to as the “New Troegs Mark”, is materially different from the Old Troegs Mark:



Email correspondence produced by Petitioner in this action this month, and dated November 16, 2010, indicates Petitioner substituted the New Troegs Mark for the Old Troegs Mark and intentionally discontinued use of the Old Troegs Mark. Specifically, Petitioner’s Brewery Manager suggests a campaign to eliminate the “old school” labels/cases for the Old Troegs Mark which would be titled “OUT WITH THE OLD/IN WITH THE NEW”, a suggestion Petitioner’s principal and founder Chris Trogner adopts, noting “technically [we] should have been using the old label continually...from a trademark stance”. This latter statement discloses that Petitioner knew there had been no continuous use of the Old Troegs Mark although it had filed a Declaration of Use on October 26, 2010, less than one month earlier.

The exchange concludes with Petitioner’s Brewery Manager stating he would “run [the old labels with the Old Troegs Mark] all out”. Both parties also refer to the very limited number of cases bearing the Old Troegs Mark in existence or to be run (with the Brewery

Manager identifying only ten cases that would bear the Old Troegs Mark when the labels were run out).

A copy of this email correspondence is appended hereto along with a proposed Amended Answer to Petition to Cancel and Counterclaims.

Based on this newly discovered evidence, Fegley has factual grounds to support counterclaims of Petitioner's fraudulent maintenance of the registration for, and abandonment of, the Old Troegs Mark, as alleged in the [Proposed] Amended Answer to Petition to Cancel and Counterclaims appended hereto. Petitioner also has grounds to assert "unclean hands" as an affirmative defense.

Under Fed. R. Civ. P. 15(a), leave to amend pleadings must be freely given when justice so requires, unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party. *Polaris Indus. v. DC Comics*, 59 U.S.P.Q.2d 1798 (T.T.A.B. 2000). The TTAB has granted leave to amend pleadings with "considerable liberality" in the past where the circumstances are such that the other party is not prejudiced. *Buffett v. Chi-Chi's, Inc.*, 226 U.S.P.Q. 428, 431 (T.T.A.B. 1985) (motion to amend notice of opposition granted; applicant would not suffer any prejudice due to fact that parties had agreed to several extensions of time which resulted in proceeding still being in fairly early stage).

Here, Fegley simply seeks to amend its Answer to the Petition to Cancel to add compulsory counterclaims petitioning to cancel a registration that is the basis for this proceeding on the legal grounds of abandonment and fraud; and to add an affirmative defense of "unclean hands". Nothing relating to this amendment would violate settled law. Moreover, this amendment would not prejudice Petitioner in that the parties only

recently exchanged documents responsive to their first requests for discovery, and discovery is not set to close in this proceeding until October 1, 2011, more than two months from the date of this motion. No depositions have been noticed or conducted and there is ample time for follow-up discovery. Indeed, it would appear all evidence relevant to Fegley's counterclaims is in Petitioner's own custody, control or possession and so Petitioner cannot be prejudiced by the amendment.

To this end, Fegley respectfully moves that the proceedings be suspended pending determination of its Motion. The amended pleading raises new issues which will affect the determination of what constitutes relevant discoverable evidence. Therefore, it does not make sense to continue discovery until the Board determines what the claims are in this proceeding. *See e.g., Sdt Inc. v. Patterson Dental Co.*, 30 U.S.P.Q.2d 1707, 1708 (T.T.A.B. 1994) ("In view of the nature of the issue raised by Opposer's motion to amend, it would be unreasonable to expect either party to take discovery or offer evidence prior to the determination of the motion."). The Board has great discretion to suspend proceedings. *See* T.B.M.P. § 510. Accordingly, Fegley respectfully requests that the proceedings be suspended pending a determination on its Motion to Amend and that discovery be scheduled to close ninety (90) days from the date of the Board's issuance of an Order in connection with this motion.

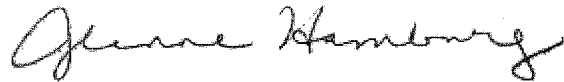
### **CONCLUSION**

Fegley has acted promptly in moving for leave to amend its Answer to the Petition to Cancel following the discovery of new evidence that gives rise to legal grounds for its counterclaims. In light thereof and the fact that Petitioner will not be prejudiced thereby, Fegley respectfully requests leave to file its [Proposed] Amended

Answer to Petition to Cancel and Amended Counterclaims attached hereto, that the proceedings be suspended pending the Board's determination on this motion and, regardless of the Board's decision, that the discovery period be set to close ninety (90) days from the issuance of an Order in connection with this motion.

Dated: New York, New York  
July 28, 2011

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Jeanne Hamburg".

Jeanne Hamburg  
NORRIS, McLAUGHLIN & MARCUS, P.A.  
*Attorneys for Registrant*  
875 Third Avenue, 8<sup>th</sup> Floor  
New York, NY 10022  
Phone 212.808.0700

**From:** Ed Yashinsky  
**To:** [ctrogner@troegs.com](mailto:ctrogner@troegs.com); "John Trogner"  
**Subject:** RE: old school elf labels  
**Date:** Tuesday, November 16, 2010 11:45:11 AM

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We should get around 10 cases with the stack that is left.

I told adam to run them all out.

\*\*\*\*\*

*Ed Yashinsky  
Brewery Manager*

*Troegs Brewing Company  
800 Paxton Street  
Harrisburg, PA 17104  
717-232-1297  
717-236-1925 (f)  
[edy@troegs.com](mailto:edy@troegs.com)*

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**From:** Chris Trogner [<mailto:ctrogner@troegs.com>]  
**Sent:** Tuesday, November 16, 2010 11:34 AM  
**To:** Ed Yashinsky; John Trogner  
**Subject:** Re: old school elf labels

I'd like to have a couple cases as back up. can you run 5 to 10 cases more? Label packs are on my wire shelves in my office..I think 3rd shelf. CT

Sent from my Verizon Wireless BlackBerry

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**From:** "Ed Yashinsky" <[edy@troegs.com](mailto:edy@troegs.com)>  
**Date:** Tue, 16 Nov 2010 11:28:11 -0500  
**To:** <[ctrogner@troegs.com](mailto:ctrogner@troegs.com)>; 'John Trogner'<[jtrogner@troegs.com](mailto:jtrogner@troegs.com)>  
**ReplyTo:** <[edy@troegs.com](mailto:edy@troegs.com)>  
**Subject:** RE: old school elf labels

If we are running them I will take the labels out right now – today's the last day.

If I a sixer per case will fly I think we are in good shape.

Let me know asap.

\*\*\*\*\*

*Ed Yashinsky  
Brewery Manager*

*Troegs Brewing Company  
800 Paxton Street  
Harrisburg, PA 17104  
717-232-1297  
717-236-1925 (f)  
[edy@troegs.com](mailto:edy@troegs.com)*



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**From:** Chris Trogner [mailto:ctrogner@troegs.com]  
**Sent:** Tuesday, November 16, 2010 11:27 AM  
**To:** Ed Yashinsky; John Trogner  
**Subject:** Re: old school elf labels

I like the idea...and it helps play up the new brewery. I would run another 10 cases just so we have them....but one 6pack per case is probably enough. CT

Sent from my Verizon Wireless BlackBerry

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**From:** "Ed Yashinsky" <edy@troegs.com>  
**Date:** Tue, 16 Nov 2010 11:09:19 -0500  
**To:** <ctrogner@troegs.com>; 'John Trogner'<jtrogner@troegs.com>  
**ReplyTo:** <edy@troegs.com>  
**Subject:** RE: old school elf labels

The name is the least of my worries....

\*\*\*\*\*

*Ed Yashinsky  
Brewery Manager*

*Troegs Brewing Company  
800 Paxton Street  
Harrisburg, PA 17104  
717-232-1297  
717-236-1925 (f)  
[edy@troegs.com](mailto:edy@troegs.com)*

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**From:** Chris Trogner [mailto:ctrogner@troegs.com]  
**Sent:** Tuesday, November 16, 2010 11:04 AM  
**To:** Ed Yashinsky; John Trogner  
**Subject:** Re: old school elf labels

We may need a different name since we technically should have been using the old label continually....from a trademark stance. I have 5 cases already from last run in my office

Sent from my Verizon Wireless BlackBerry

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**From:** "Ed Yashinsky" <edy@troegs.com>  
**Date:** Tue, 16 Nov 2010 11:00:35 -0500  
**To:** 'Chris Trogner'<ctrogner@troegs.com>; 'John Trogner'<jtrogner@troegs.com>  
**ReplyTo:** <edy@troegs.com>  
**Subject:** old school elf labels

Thinking of what to do with the old school elf labels cases. How about this:

OUT WITH THE OLD/IN WITH THE NEW

We take ten cases of mad elf, break them open and put two old six-packs and two new six packs in each box. We also include a letter from you guys informing the lucky buyer that they have received a special case of beer.

I think it makes sense to give these cases to reps and have them hand-deliver to 10 beer distributors (all in Pennsylvania). Thinking of the following breakdown: two cases, greater Harrisburg, one case Lancaster, one case york, on case state college, three cases greater Philadelphia, two cases greater Pittsburgh.

Each of these people receive an invitation to whatever kind of final event we do here at the brewery and they receive an invitation to the new brewery opening event.

We can flesh this out if you think it makes sense.

ALSO – if we have to sell full old cases as is, the breakdown could be: 1 harrisburg, 1 lancaster, 1 state college, 1 pittsburgh, 1 philadelphia.

\*\*\*\*\*

*Ed Yashinsky  
Brewery Manager*

*Troegs Brewing Company  
800 Paxton Street  
Harrisburg, PA 17104  
717-232-1297  
717-236-1925 (f)  
[edy@troegs.com](mailto:edy@troegs.com)*

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of U.S. Registration No. 3,047,757  
For the mark RUDE ELF'S RESERVE and Design  
Registered on January 24, 2006

TROEGS BREWING COMPANY,

Petitioner/Counterdefendant,

vs.

FEGLEY ENTERPRISES, INC.,

Registrant/Counterclaimant.

Cancellation No. 92053542

**[PROPOSED] AMENDED ANSWER TO PETITION TO CANCEL  
AND COUNTERCLAIMS**

Registrant FEGLEY ENTERPRISES, INC. ("Fegley") for its Answer to the  
Petition to Cancel filed in this proceeding, by its attorneys, alleges as follows:

1. Denies knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 1 of the Petition to Cancel.
2. In response to paragraph 2 of the Petition to Cancel, denies that U.S. Reg. No. 3,047,757 is for "RUDE ELF" alone without reference to other subject matter in the registration and admits that its corporate name and address are as alleged in the Petition to Cancel.
3. In response to paragraph 3 of the Petition to Cancel, refers to the records of the U.S. Patent and Trademark Office ("USPTO") for the particulars of the filings referred to in paragraph 3 of the Petition to Cancel.

4. In response to paragraph 4 of the Petition to Cancel, refers to the records of the USPTO for the particulars of the USPTO filings and actions referred to in paragraph 4 of the Petition to Cancel.

5. In response to paragraph 5 of the Petition to Cancel, refers to the records of the USPTO for particulars of its registration and denies that such registration is for the “RUDE ELF mark” without reference to additional subject matter.

6. Denies the allegations of paragraph 6 of the Petition to Cancel.

7. Denies the allegations of paragraph 7 of the Petition to Cancel.

8. Denies the allegations of paragraph 8 of the Petition to Cancel.

9. In response to paragraph 9 of the Petition to Cancel, refers to the records of the USPTO for particulars as to Registration Nos. 2,887,242 and 3,035,721 and denies that they are the “MAD ELF Registrations” insofar as such a label does not adequately communicate other subject matter covered by the registrations.

10. Denies the allegations of paragraph 10 of the Notice of Opposition insofar as the relevant consuming public does not refer to the registrations as the “MAD ELF Mark” without reference to additional subject matter in the registrations.

11. In response to paragraph 11 of the Petition to Cancel, refers to the refers to the records of the U.S. Patent and Trademark Office for particulars as to Registration Nos. 2,887,242 and 3,035,721 and denies that they are “the MAD ELF Registrations”

12. Denies knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 12 of the Petition to Cancel.

13. Denies knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 13 of the Petition to Cancel.

14. Denies knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 14 of the Petition to Cancel.

15. Denies knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 15 of the Petition to Cancel.

16. Denies the allegations of paragraph 16 of the Petition to Cancel.

17. Denies knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 17 of the Petition to Cancel.

18. Denies knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 18 of the Petition to Cancel.

19. In response to the allegations of Paragraph 19 of the Petition to Cancel, repeats and re-alleges its responses to the allegations of paragraphs 1 through 18 of the Petition to Cancel.

20. Denies knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 20 of the Petition to Cancel.

21. Denies knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 21 of the Petition to Cancel.

22. Denies the allegations of paragraph 22 of the Petition to Cancel.

## **AFFIRMATIVE DEFENSES**

### **FIRST AFFIRMATIVE DEFENSE**

The Petition to Cancel fails to state a claim upon which relief may be granted.

### **SECOND AFFIRMATIVE DEFENSE**

The claim set forth in the Petition to Cancel is barred in whole or in part by the doctrine of laches.

### **THIRD AFFIRMATIVE DEFENSE**

The claim set forth in the Petition to Cancel is barred in whole or in part by the doctrines of waiver, acquiescence, estoppel and unclean hands.

WHEREFORE, Registrant requests that Petitioner's Petition to Cancel be dismissed.

### **COUNTERCLAIMS**

Counterclaimant, Fegley Enterprises Inc. ("Fegley"), a corporation duly organized under the laws of the State of Pennsylvania with an address of 569 Main Street, Bethlehem, Pennsylvania 18018, believes it will be damaged by the continued registration of U.S. Trademark Registration No. 2,887,242 by Counterdefendant Troegs Brewing Company ("Counterdefendant") and, by and through its undersigned counsel, hereby petitions to cancel this registration for the reasons stated in the First and Second Counterclaim below.

#### **FIRST COUNTERCLAIM**

On information and belief, Counterdefendant has discontinued use of the mark shown in U.S. Reg. No. 2887242 for "beer, ale and lager" with no intent to resume use, thus abandoning the mark. Accordingly, the registration should be canceled.

#### **SECOND COUNTERCLAIM**

On information and belief, Counterdefendant committed a fraud on the USPTO by filing a false Combined Declaration of Use & Incontestability Under Sections 8 & 15 ("Declaration of Use") on October 26, 2010. In that declaration, Petitioner stated that the "mark has been continuously used in commerce for five (5) consecutive years after the date of registration" and "is still in use" in connection with beer, ale and lager. On

information and belief, the Declaration of Use was knowingly false because Counterdefendant stated that the mark was “still in use in commerce” when Counterdefendant knew that any use made by it was a sham or token use; and stated that the mark had been continuously used in commerce for five consecutive years after the date of registration when Counterdefendant knew the mark had not been so used. If the USPTO was aware that the statements in the Declaration of Use were false, it would not have permitted the registration to remain in force. As a result of the fraud perpetuated on the USPTO, Counterdefendant’s mark is being fraudulently maintained on the Principal Register to the detriment of Fegley. Accordingly, the registration should be invalidated.

WHEREFORE, in accordance with Section 14 of the Trademark Act, Fegley prays that these Counterclaims be sustained and that U.S. Registration No. 2,887,242 be cancelled.

Dated:                                  2011  
New York, New York

Respectfully submitted,

Jeanne Hamburg  
NORRIS, McLAUGHLIN & MARCUS, P.A.  
*Attorneys for Registrant*  
875 Third Avenue, 8<sup>th</sup> Floor  
New York, NY 10022

Phone 212.808.0700

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of U.S. Registration No. 3,047,757  
For the mark RUDE ELF'S RESERVE and Design  
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vs.

FEGLEY ENTERPRISES, INC.,

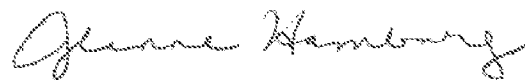
Registrant/Counterclaimant.

Cancellation No. 92053542

CERTIFICATE OF SERVICE

I hereby certify that on July 28, 2011 a copy of the foregoing Motion For Leave To Amend Answer To Add Counterclaims And To Suspend Proceeding Pending Determination Of This Motion, accompanying attachment comprised of an email exchange dated November 16, 2010, and [Proposed] Amended Answer to Petition to Cancel and Counterclaims is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to the attorneys for Petitioner as follows:

Harvey Freedenberg  
Brian P. Gregg  
100 Pine Street  
P.O. Box 1166  
Harrisburg, PA 17108



Jeanne Hamburg